



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/825,431

04/03/2001

Stuart D. Baker

209.1001

2071

7590 11/17/2008  
DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 Seventh Avenue, 14th Floor  
New York, NY 10018

EXAMINER

DESAI, RACHNA SINGH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

11/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/825,431	<b>Applicant(s)</b> BAKER ET AL.	
	<b>Examiner</b> RACHNA S. DESAI	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27, 41-59 and 71-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 41-59, and 71-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to communications: A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/08 has been entered.

2. Claims 1-27, 41-59, and 71-73 are currently pending. Claims 1, 18, 41, 49, 57, 71, and 72 are independent claims. Claim 73 is a newly added claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-27, 41-59, 71 and 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson, III et al. ("Dickinson"), U.S. Patent Application Publication No. 2003/0196098, in further view of Liu et al. ("Liu"), U.S. Patent No. 6,760,752.**

**Regarding independent claim 1, Dickinson discloses:**

*A digital communication system to denote confidentiality of a digital communication comprising (see Title and Abstract):*

*a memory containing a program executable by the processor to (see para [0018] → The system takes the form of a program executing on a conventional general purpose computer):*

*attach a privileged attribute to a digital communication when the electronic communication is created (see paras [0023], [0025], and [0030-0031] → The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);*

*create a privileged distribution list of at least one intended recipient when the electronic communication is created (see paras [0022-0023] → Dickinson teaches a recipient policy list); and*

*a second memory containing a program executable by a processor to:*

*restrict access to the privileged digital communication to the at least one intended recipient (see paras [0009], [0024] and [0030-0031]: The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);*

*restrict routing of the privileged digital communication to the at least one intended recipient* (see paras [0009], [0024] and [0030-0031]:

Dickinson teaches a recipient policy list) and,

*store the privileged digital communication in a segregated location (...) on a data storage device* (see paras [0010] and [0040-0041] → The messages may be stored at specific segregated destinations or queues).

Dickinson does not explicitly disclose Applicant's newly amended claim language ("*a first memory*", "*a second memory*", "*associate the privileged distribution list with the digital communication*") that limits the digital communication system to a system wherein the communication itself controls the disposition of where the communication may be sent (see Applicant's Argument pg. 12). Dickinson also does not explicitly disclose a segregated location specifically for privileged digital communications.

However, Liu discloses a secure transmission system wherein a first memory attaches an encrypted/confidential signed message as an attachment to an e-mail message and transmits the e-mail message to the intended recipient of the distribution list (see col. 1 lines 54-65 and col. 2 lines 45-51).

Liu further discloses a second memory that restricts access and routing of the encrypted/confidential communication (see column 1, lines 54-65 and column 2, lines 46-51. col. 2 lines 1-4, 62-67; col. 3 lines 35-52).

Moreover, Liu discloses storing the digital communication in a segregated location for privileged communications (see col. 21 lines 6-20).

Since both references are from the same field of endeavor, the motivational purpose of providing secure data transmissions between Internet users as disclosed by Liu would have been recognized in the pertinent art of Dickinson. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Dickinson with the teachings of Liu to include a system wherein the communication itself controls the disposition of where the communication may be sent and a segregated location specifically for privileged digital communications.

**Independent claim 18** incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

**Regarding claims 41**, Dickinson discloses:

*A method for creating attorney-client privileged digital communication* (see Title and Abstract):

*creating an electronic communication.*

*marking a communication privileged with a privileged attribute when the electronic communication is created.* (see paras [0023], [0025], and [0030-0031] → The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);

*store the privileged digital communication in a segregated location*  
(...) *on a data storage device* (see paras [0010] and [0040-0041] → The  
messages may be stored at specific segregated destinations or queues).

*configuring access rights to the electronic communication . . . when*  
*the electronic communication is created.* (see paras [0009], [0024] and  
[0030-0031]: The policy modules operate on confidential attachments to e-  
mails to require either encryption, signature, or both, in order to enforce  
attorney-client privileges);

Dickinson does not explicitly disclose forwarding of the communication. However, it  
was commonly known to those of ordinary skill in the art and would have been obvious  
at the time the invention was made to a person having ordinary skill in the art to  
forward the communication for the motivational purpose of comprising the major  
common functional components of a user-friendly e-mail system.

Dickinson does not explicitly disclose *associate the privileged distribution list with*  
*the digital communication*) that limits the digital communication system to a system  
wherein the communication itself controls the disposition of where the communication  
may be sent (see Applicant's Argument pg. 12). Dickinson also does not explicitly  
disclose a segregated location specifically for privileged digital communications.

Liu discloses storing the digital communication in a segregated location for  
privileged communications (see col. 21 lines 6-20).

Since both references are from the same field of endeavor, the motivational  
purpose of providing secure data transmissions between Internet users as disclosed by

Liu would have been recognized in the pertinent art of Dickinson. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Dickinson with the teachings of Liu to include a system wherein the communication itself controls the disposition of where the communication may be sent and a segregated location specifically for privileged digital communications.

**With respect to independent claims 49, 71 and 72**, please refer to the rationale relied upon to reject independent claim 1, which contains substantially similar subject matter, as discussed above.

**Regarding claim 2**, Dickinson, in view of Liu, disclose wherein the at least one intended recipient is a plurality of intended recipients (see para [0031] → policies can be applied to users, either individually or by groupings).

**Regarding claim 3**, Dickinson, in view of Liu, disclose a mail server (see para [0034]); a segregated server housing the segregated location (...) (see paras [0034-0038]); wherein the program is further executable to send a copy of the communication to the segregated server (see paras [0010], [0034-0038], and [0040-0041]), and a segregated location for privileged digital communications.

**Regarding claims 4 and 46**, Dickinson does not explicitly disclose sending a copy as a blind carbon copy system. However, it was commonly known to those of



ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claims 5 and 47,** Dickinson discloses a communication system (i.e. e-mail) containing a plurality of user specified information fields, such as source field specifying an e-mail address for the source of the message, a destination field specifying one or more destination e-mail addresses for the message, a subject field specifying a subject for the message, a body field specifying the body of the message containing textual and/or graphics data, and an optional attachment field, specifying one or more files to be transmitted with the message. Other user specified fields include, but are not limited to, priority of the message, identity of the sending agent, and the date and time of the message (see para [0019]).

Dickinson does not explicitly disclose a characteristic including a department of a corporation using the system. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a characteristic including a department of a corporation using the system, forwarding of the communication for the motivational

purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claims 6 and 50**, Dickinson, in view of Liu, disclose configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paras [0009], [0024] and [0030-0031]).

**Regarding claim 7, 19, and 51**, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paras [0009], [0024] and [0030-0031]). Dickinson does not explicitly disclose forwarding of the communication. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to forward the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claim 8, 20, 42, and 52**, Dickinson does not explicitly disclose copying and cutting contents into another location. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include copying and

Art Unit: 2176

cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claims 9, 21, and 54**, Dickinson, in view of Liu, disclose executing automatically and attaching the privileged attribute or the executable module to particular communications according to predetermined selection criteria (see para [0022-0031]; please refer also to the rationale relied upon to reject independent claim 18).

**Regarding claims 10, 22, and 55**, Dickinson, in view of Liu, disclose a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

**Regarding claim 11**, Dickinson does not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with* “confidentiality notice”).

**Regarding claims 12, 23, 56, and 59**, Dickinson, in view of Liu, disclose the system wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met (see Abstract and para [0007] et seq.).

**Regarding claims 13 and 24**, Dickinson, in view of Liu, disclose a server object and a client object (see paras [0034-0037]).

**Claims 14, 15, 17, 25, 26, and 53** incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

**Regarding claims 16 and 27**, Dickinson, in view of Liu, does not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plugs in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system.

**Regarding claim 43**, Dickinson, in view of Liu, disclose executing automatically and attaching the privileged attribute to particular communications according to predetermined selection criteria (see para [0022-0031]).

**Regarding claims 44**, Dickinson, in view of Liu, disclose a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e., notification actions).

**Regarding claims 45**, Dickinson, in view of Liu, disclose the system wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met (see Abstract and para [0007] et seq.).

**Claim 48** incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

**Claims 57 and 58** incorporate substantially similar subject matter as independent claim 18 and are rejected along the same rationale.

**Regarding claim 73**, Dickinson teaches the intended recipient email is entered into the "to" text box of a digital communication. See figure 2, "source:", element 205.

***Response to Arguments***

5. Applicant's arguments with respect to newly amended claims filed on 10/20/08 have been considered but are not persuasive.

On page 13 of the Remarks, Applicant argues the amended claims are not met by the prior art references. Specifically, Applicant argues the cited references do not teach creation and/or association of the privileged distribution lists of at least one intended recipient with the communications at the time of creation of the communications.

Examiner disagrees.

Applicant's position seems to be surrounded around the notion that the actions by a policy engine are not part of the digital communication creation. Examiner believes the policy engine actions are part of creating a digital communication and therefore, the teachings of Dickinson do occur when the communication is created. With respect to a privileged distribution list, Dickinson teaches a recipient policy list. See paragraphs [0022-0023].

Applicant argues Dickinson's lists are lists of sender/recipient policies, rather than lists of at least one intended recipient and that the lists are created after the policy engine accepts messages from the SMTP relay module and are not built when the communications are created.

Examiner disagrees.

Applicant's position seems to be surrounded around the notion that the actions by a policy engine are not part of the digital communication creation. Examiner believes the policy engine actions are part of creating a digital communication and therefore, the teachings of Dickinson do occur when the communication is created. With respect to a privileged distribution list, Dickinson teaches a recipient policy list. See paragraphs [0022-0023].

Applicant argues Dickinson does not teach attaching a privileged attribute to a digital communication, but teaches policies as part of an e-mail firewall and entered by an administrator of the firewall after the messages are received by the SMTP relay module.

Examiner disagrees.

As stated above, Applicant's position seems to be surrounded around the notion that the actions by a policy engine are not part of the digital communication creation. Examiner believes the policy engine actions are part of creating a digital communication and therefore, the teachings of Dickinson do occur when the communication is created. With respect to a privileged distribution list, Dickinson teaches a recipient policy list. See paragraphs [0022-0023].

On pages 13-14, Applicant argues Liu fails to teach a second memory that restricts access and routing of the encrypted/confidential communication.

Examiner disagrees.

Liu teaches routing the encrypted message to a designated recipient. See column 1, lines 54-65, column 2, lines 46-51, col. 3, lines 35-52. Liu teaches accessing and routing an email message to a designated recipient.

With respect to Applicant's argument that Liu does not teach a privileged distribution list, Examiner disagrees. Liu teaches associating a distribution list (i.e. recipient list) with the communication as in columns 1, lines 54-65 and column 2, lines 46-51. Therefore, Liu teaches restricting the routing and accessing of the communication according to a distribution list.

In view of the comments above, the rejections are maintained.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHNA S. DESAI whose telephone number is (571)272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



Art Unit: 2176

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rachna S Desai/  
Primary Examiner, Art Unit 2176  
11/06/08